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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,781	02/25/2004	Sheng-Hsin Hu	K-C 16029.1	3777

7590 11/26/2004

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EXAMINER

TSOY, ELENA

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,781

Applicant(s)

HU ET AL.

Examiner

Elena Tsoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/25/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Applicant's election of species including claims 1-3, 6-13, 17-20 in the reply filed on October 18, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 1-20 are pending in the application. Claims 5, 14-16 are withdrawn from consideration as directed to a non-elected invention.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 6, 8, 9, 13, 17-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hiltzik et al (US 20030082382).

Hiltzik et al disclose a method for producing coated activated carbon material, comprising providing activated carbon material in a fluidized bed (See P30), combining any colored pigment (a masking agent) and an (aqueous) emulsion of polymer such as polyisoprene (rubber), polychloroprene (rubber), polybutadiene (rubber) (claimed water insoluble elastomer) to form a coating liquor (See PP21, 32), spraying the coating liquid onto the activated carbon material while it is fluidized (See P25), drying (curing) the coating liquor to form a coating material at from just below ambient at about 50°F or ambient 70°F (21°C) to 280°F (121°C) (See

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P29) using heated air (See P36), wherein the coating material on the activated carbon material is substantially water insoluble (See P26).

It is the Examiner's position that coating has a Shore A hardness of less than about 70 inherently because claimed polymer is also polyisoprene rubber, polychloroprene rubber, polybutadiene rubber (See specification, page 12, lines 4-6).

4. Claims 1, 4, 7, 9, 10, 12, 13, 17, 18, 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Karapasha (WO9112030).

Karapasha discloses a method for producing coated activated carbon material, comprising providing activated carbon material in a fluidized bed (See page 27, lines 17, 29), combining a colored pigment (a masking agent) such as zeolites (catalyst) including silica/alumina zeolites (See page 14, lines 1-23), silica, TiO₂ (catalyst), chalk, ZrO₂ (See page 14, lines 32-34), and an aqueous dispersion (suspension) (See page 15, line 1) of polymer binder (claimed water insoluble polymer) to form a coating liquor, spraying the coating liquid onto the activated carbon material while it is fluidized, drying (curing) the coating liquor to form a coating material at 50⁰F or ambient 138⁰F (59⁰C) using heated air (See page 27, lines 29-37).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiltzik et al (US 20030082382) or Karapasha (WO9112030).

Hiltzik et al/Karapasha are applied here for the same reasons as above. Hiltzik et al/Karapasha fail to teach that the pigment has an absolute HunterLab "a" value or absolute HunterLab "b" value greater than 10.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined the optimum values of the relevant HunterLab parameters (including those of claimed invention) in Hiltzik et al/Karapasha through routine experimentation depending on intended use of a final product in the absence of a showing of criticality.

It is held that it is not inventive to discover the optimum or workable ranges of result-effective variables by routine experimentation. In re Antonie, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). See also In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELENA TSOY
PRIMARY EXAMINER

Elena Tsoy
Primary Examiner
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A handwritten signature in cursive script, appearing to read 'ETsoy', is positioned below the printed name and title.

November 23, 2004